



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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#8

In re application of: Robert Sackstein

Serial No. 09/619,290

Group Art Unit: 1646

Filed: 07/19/00

Examiner: Unknown

For: SULFATION-INDEPENDENT L-SELECTIN OR
E-SELECTIN LIGAND (HCELL) AND THERAPEUTICS
THEREOF

Attorney Docket No: 0152.00378

REQUEST FOR RECONSIDERATION

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This is in response to the Decision Refusing Status Under 37 CFR 1.47(b) dated May 24, 2002. Attached please find a Declaration setting forth proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration, and proof of irreparable damage.

Respectfully submitted,

KOHN & ASSOCIATES, PLLC

Amy E. Rinaldo
Registration No. 45,791
30500 Northwestern Highway
Suite 410
Farmington Hills, Michigan 48334
(248) 539-5050

Dated: September 24, 2002

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 on September 24, 2002.

Connie Herty

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REVENUE ALLOCATION AGREEMENT

This Agreement is entered into this 5 day of October, 1994, by and among the University of South Florida, acting for and on behalf of the Board of Regents, a public corporation of the State of Florida, of 4202 E. Fowler Avenue, Tampa, Florida 33620 ("University"), the University of South Florida Research Foundation, Inc., a university direct-support organization under Florida law, of 4202 E. Fowler Avenue, Tampa, Florida 33620 ("Research Foundation"), and Robert Sackstein, an individual residing in the State of Florida ("Inventor"). The purpose of this Agreement is to define a basis for cooperation between the parties in the development, protection, and commercial exploitation of a certain invention made by Inventor.

INTRODUCTION

1. Inventor is employed by, or is a student of, University and has made a certain invention described hereinafter.
2. Inventor, University, and Research Foundation desire to cooperate in the development, protection, and commercial exploitation of the said invention.

In consideration of the above premises and the mutual covenants and conditions contained herein, Inventor, University, and Research Foundation agree as follows:

1. Definitions.

- 1.1 **Subject Invention(s).** The term "Subject Invention(s)" as used in this Agreement means any discovery, invention, process, composition of matter, article of manufacture, know-how, design, model, technological development, program or other works, strain, variety, culture of any organism, or portion, modification, translation, or extension of these items, and any mark used in connection with these items, which is conceived or authored by Inventor and is more particularly described in Inventor's Disclosure of Invention entitled, *Detection of an L-Selectin Ligand on a Hematopoietic Progenitor Cell Line* dated September 6, 1994.
- 1.2 **Patent Rights.** The term "Patent Rights" as used in this Agreement means:
 - (a) Any U.S. patent application hereafter filed covering any Subject Invention(s), any division, continuation, and continuation-in-part of any such application, and any patent which shall be issued based on such application, division, continuation, and continuation-in-part; and
 - (b) Any patent which is a reissue or an extension of, or a patent of addition to, any patent defined in (a) above; and

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- (c) Any patent application or patent corresponding to any patent application or patent identified in (a) or (b) above which is hereafter filed or issued in any country other than the United States.
- (d) Any other right(s) existing under Federal or State statutes or common law to exploit, exclusively and nonexclusively, any Subject Invention(s), including but not limited to the rights to all associated trade secrets and know-how, and to copyrights.

2. Commercialization of Patent Rights.

- 2.1 Inventor agrees to and does hereby assign to University, and University agrees to exclusively license to Research Foundation their entire right, title, and interest in and to the Subject Invention(s), and the Patent Rights pertaining thereto for the purpose of commercial exploitation thereof for the benefit of Inventor and University in accordance with the terms of this Agreement and other applicable agreements, policies, and laws.
- 2.2 University, Research Foundation, and Inventor shall cooperate as follows in the filing, prosecution, assignment, and maintenance of the Patent Rights, and in the commercial exploitation of the Patent Rights:
 - (i) The filing, prosecution, assignment, and maintenance of the Patent Rights shall be carried out by University. Inventor shall cooperate with Patent Counsel designated and engaged by University. All decisions regarding the scope of patent coverage, claim language, and other matters bearing on the substantive content of patents included in the Patent Rights, and the filing of foreign patent applications, shall be made by University in consultation with Patent Counsel and Inventor. Research Foundation may agree that a sublicensee will, at its own expense, carry out the filing, prosecution, assignment, and maintenance of the Patent Rights.
 - (ii) University shall be responsible for the payment of all costs, expenses, taxes, and attorney's fees relating to the filing, prosecution, assignment, and maintenance of patent applications and patents included in the Patent Rights; provided that Research Foundation may require licensees to pay or reimburse Research Foundation and/or University for such costs, expenses, taxes, and fees.
 - (iii) Research Foundation agrees to use its best efforts to commercialize the Patent Rights by licensing or selling the Patent Rights to third parties. It will be the responsibility of Research Foundation to screen and select qualified potential licensees and purchasers, and to prepare and negotiate the terms of any sublicense or purchase agreement (hereinafter License Agreements), provided that University and Inventor shall meet and confer with Research Foundation regarding specific aims of such negotiations and provided further that all such licensees and License Agreements (and any amendments or waivers thereto) must be approved in advance by University. Such License Agreements shall provide that all amounts payable as license fees, royalties, or like proceeds shall

be paid to Research Foundation, and Research Foundation shall, in .
Inventor a share of such proceeds in accordance with Section 2.2(i).
Agreement. Research Foundation agrees to provide to Inventor and U
a copy of any fully executed License Agreement (and any amendme
waivers thereto) within thirty (30) days after execution thereof.

- (iv) Research Foundation agrees that any amounts received by Research Foundation as license fees, royalties or like proceeds under any License Agreement respecting the Patent Rights shall be held and administered in accordance with the terms of this Agreement and other applicable agreements, policies, and laws. In accordance with the pertinent Collective Bargaining Agreement, USF Rule, and the University's Statement of Policy regarding Inventions and Works, Research Foundation shall allocate and pay the following shares of net revenue:
- (1) Inventor shall receive Forty-Five percent (45%) of net revenue;
 - (2) Research Foundation shall deposit Ten percent (10%) of net revenue into a fund to be used exclusively for the purpose of supporting research and educational activities as determined by the accountable officer, subject to University and Research Foundation policies and approval. The accountable officer for this fund shall be Inventor during the period of his employment by the University. Upon Inventor's termination or retirement from University employment, this Ten percent (10%) shall thereafter be equally divided between Inventor and Research Foundation.
 - (3) As used herein, the terms "net revenue" mean gross revenue received by Research Foundation from commercial application of the Patent Rights, including amounts received by Research Foundation as license fees, royalties, or like proceeds under any License Agreement respecting the Patent Rights, minus University's and Research Foundation's direct costs incurred in protecting, maintaining, licensing, and preserving the Patent Rights.
- (v) Research Foundation agrees to permit Inventor to inspect, copy, and audit Research Foundation's records pertaining to Research Foundation's proceeds under the License Agreement(s) and Research Foundation's payments to Inventor pursuant to Section 2.2 (iv) above.
- (vi) Research Foundation may at any time elect to withdraw from this Agreement and, at Inventor's request, University may assign to Inventor the entire right, title, and interest in the Patent Rights, or any of them, including any corresponding interest in proceeds from the commercial exploitation of the Patent Rights, or any of them. In this event, neither University nor Research Foundation shall have further obligation to pursue protection and commercial exploitation of the Patent Rights or to pay any further costs and expenses which may be incurred in connection therewith, except that University shall be responsible for the payment of any costs, expenses, and liabilities incurred by University through the date of

such withdrawal. Upon such withdrawal and assignment to Inventor, neither Research Foundation nor University shall thereafter have any rights regarding or exercise any control over negotiations regarding commercial utilization and exploitation or other management and administration of the Patent Rights.

- (vii) The obligation of Research Foundation to allocate and pay to Inventor the above specified share of Research Foundation's proceeds under any License Agreement(s) respecting the Patent Rights shall be in effect for the life of such License Agreement(s) and shall inure to the benefit of Inventor, and his/her successors and assigns, irrespective of whether Inventor is employed by University.

3. General Provisions.

- 3.1 **Notices.** Any notice or other communication under this Agreement shall be in writing and shall be sent by certified or registered mail, first class, postage prepaid, or personally delivered to:

UNIVERSITY:

Office of Research
University of South Florida
4202 East Fowler Avenue, FAO 126
Tampa, Florida 33620-7900

RESEARCH FOUNDATION:

USF 3004
Tampa, Florida 33620-3004

INVENTOR:

Robert Sackstein, M.D., Ph.D.

Any party may, by written notice to the other parties, change the address to which notices shall be directed.

- 3.2 **Governing Law.** The parties shall endeavor to resolve any claims, disputes, and controversies arising under this Agreement by good-faith negotiation. This Agreement shall be governed by the laws of the State of Florida.
- 3.3 **Entire Agreement.** This constitutes the entire Agreement of the parties and supersedes all prior written or oral agreements on the subject matter hereof. Any change or addition to this Agreement shall be in writing and executed by the duly authorized representatives of the parties.
- 3.4 **Liability Protection.** It is understood and acknowledged that Inventor's activities pursuant to the research and development program described in Section 2 above are within the scope of Inventor's employment by University, and Inventor is therefore protected against personal liability arising therefrom in accordance with the terms of Statute 768.28(9)(a), Florida Statutes (1989).

3.5 Counterparts. This Agreement may be executed in any number of counterparts, each of which shall be deemed an original, and all counterparts shall constitute one and the same Agreement, which shall be sufficiently evidenced for all purposes by any one executed counterpart.

IN WITNESS WHEREOF, the parties hereto have caused this Agreement to be executed by their respective, duly authorized representatives.

"University"

UNIVERSITY OF SOUTH FLORIDA, acting for and on behalf of the Board of Regents, a public corporation of the State of Florida

Deanna Bondie
Witness

BY: Seagel Hunkeler

TITLE:

Vice President for Research

"Research Foundation"

UNIVERSITY OF SOUTH FLORIDA RESEARCH
FOUNDATION, INC.

Deanna Bondie
Witness

BY: Grasler

TITLE:

Executive Director

"Inventor"

Deanna Bondie
Witness

BY: Robert Satter

Social Security Number: 267-15-9185